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10/080,065	02/19/2002	Yevgeniy Eugene Shteyn	US 028015	8549 ..

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/080,065

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4-22-02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because those method claims are presented in the instant application a flow diagram is not presented, which *clearly* displays the functionality of the claimed method. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 8-10, and claims 2-7 through their dependence thereon. It is not clear what is meant by "innovative aspect" nor is it clear what is being subjected to the "enabling" steps.

Regarding claims 8-10 it is not clear as to what the structural features of the software or database that applicant desires are to cover, lending indefinite claim language.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-7.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

***I. Technological Arts Analysis***

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claims are directed towards a user's interaction with a "virtual environment" and the detection of "innovative aspects". As disclosed this represents a mere manipulation of abstract concepts, which is devoid of any tangible

physical structure or practical application of technology therein beyond the nominal recitation of such in a "virtual environment" as defined by the specification.

#### ***I.A. Nominal recitation of technology***

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, **even** if the "virtual environment set forth in the perceived preamble of claims 1-7, was held to be bound within the use of technology these recitations are not functionally incorporated into the body of the claim in such a manner as to provide functionality inter-connect process.

#### ***II. Useful, Concrete and Tangible Analysis***

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. *["Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.]*

In the present case, the detection of an innovative aspect represents a non-concrete result as though the user may perform an innovative aspect the detection of this is limited by the detecting system and further defined in that which is innovative to

the determining system only at that instance of time. Further the limitation of “enabling to benefit” is non-definitive as there is no reliably predictable result in which the user would benefit from their innovative aspect if the user did not continue to utilize their innovative aspect, others were not interested in their innovative aspect, and/or their innovative aspect produced results less effective than a known aspect presently available. Furthermore, the result claimed in that the user “benefits” from registering the information. It is the examiners position that this “benefit” is not a tangible result.

Claims 2-7 fail to correct the deficiency of claim 1 presented above and ergo are rejected under the statute for the reasons laid forth herein.

4. Regarding claims 8-10 in addition to the above stated.

The following is drawn from the MPEP Section 2106.

#### 2106 Patentable Subject Matter — Computer-Related Inventions

##### (a) Functional Descriptive Material: “Data Structures” Representing Descriptive Material

###### Per Se or Computer Programs Representing Computer Listings Per Se

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer

software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

In the present case the language directing the invention towards a composition of data represents an abstract idea devoid of physical structure devoid of a tangible medium and as represent an issue in addition to the those addressed regarding the innovative aspects set forth above and provide an additional grounds for presenting non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the examiner has considered each of these factors in arriving at the conclusion that the invention could not produce a concrete result without undue experimentation. The

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evidence in the application file has been considered for each of these factors as a whole and all of the factual considerations have been weighed. Specifically, the intended operation of the process is to detect an innovative aspect in an interaction with a user.

The factors used in the process are very subjective in nature (determining what is innovative and what is not.), with any result of the process being speculative at best.

Applicant has not set forth any objective evidence or direction in the record that would lead one of ordinary skill in the art to be able to analyze these highly subjective factors and arrive at a specific, predictable result. The very low predictability of this invention due to the subjective nature of the elements used therein, coupled with the lack of direction provided by the specification and the subjective nature of the invention far outweigh all other *Wands* factors when considering the necessity for undue experimentation.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



8. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan (US 2002/0076674).

Kaplan teaches a virtual environment (Network, Figure 5) including allowing a user to submit innovative ideas (posts) associated with the user who submitted them (Para 47&145-146) and stored in a local database in order to allow other users to then proceed to retrieve the ideas (Para 187) and post rewards for information (Para 21-22 & 58-61). The rewards are assigned to those who submitted the idea/answer based on its effectiveness and the submitter is then rewarded, thereby benefiting from the submission with a monetary reward (Para 60-63) and capturing exclusive right to the reward in the case of being the only submitter. As the system is driven by the rewards posted, the information is understood to be provided on the condition of a reward being posted/offered for said information. The system further includes implementations in various computer games (Para 222) or electronic games as understood.

9. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossides (US 5,359, 508).

Rossides teaches an online (Col 1:7-15) computer database system that detects the submission of new information (Elm 16) by users, stores this information in a database and allows the users to profit from their submission by allowing the users to receive royalties for the submission of this information (Col 1:25-29).

The online environment of Rossides provides a virtual environment as claimed, which "detects innovative aspects" through the comparison of the data submitted (Elm

15) with the data present in the database (Elm 16) and in the case that this data is determined not to exist in the database entering the data into the database (Elm 17) and associating the user with the their submission for the payment of royalties (Elm 18).

This is believed to encompass at least claims 1, 8, 9, and 10 as best understood as the claimed "detecting innovative aspect" represents a type of information and the comparison of the user information with the information stored in the database as demonstrated by Rossides above.

It is the examiner's interpretation that the registration of the detected innovative aspect with the benefit (or advantage) of receiving a monetary reward (or royalty) being solely assigned to the original submitter of the innovative aspect (Col 232-44) gives the submitter the exclusive right to benefit from the monetary reward associated with the other users conditional right to purchase the information (Col 7:39-56) as claimed in claims 2,3,5, and 6, and further demonstrated in the citations above as well as Figure 1.

It is the examiner's interpretation that the providing of the user's name to other users represents the providing of data to other users and as such is encompassed by not only the understood functionality of the system of Rossides demonstrated above, but also the telephone directory example included wherein the name of the user is provided along with the telephone number of that user or the providing of "the information and a name of the user available to other users" (Col 8:40-58 & Col 5:6-9) as presented in at least claim 4.

It is the examiner's interpretation that Rossides teaches an electronic gaming environment in the disclosure of a probabilistic metering function wherein the user is

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allowed to place bets and either win or lose monies in a Numbers Game or Lotto associated with these bets (Col 13:46-61 & Col 14:55-70) as claimed in at least claim 7. Further under this interpretation the virtual environment is understood to be encompassed by the telephone computer interface.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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